

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 2002P10682WO	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/DE2003/002214	International filing date (day/month/year) 27 June 2003 (27.06.2003)	Priority date (day/month/year) 03 July 2002 (03.07.2002)
International Patent Classification (IPC) or national classification and IPC H04Q 7/38		
Applicant SIEMENS AKTIENGESELLSCHAFT		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 6 sheets, including this cover sheet.
☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
These annexes consist of a total of _____ sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 15 January 2004 (15.01.2004)	Date of completion of this report 12 October 2004 (12.10.2004)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/DE2003/002214

I. Basis of the report

1. With regard to the elements of the international application:*

- ☐ the international application as originally filed
- ☒ the description:
 pages _____ 1-6 _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☒ the claims:
 pages _____ 1-9 _____, as originally filed
 pages _____, as amended (together with any statement under Article 19
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☒ the drawings:
 pages _____ 1/1 _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☐ the sequence listing part of the description:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

- These elements were available or furnished to this Authority in the following language _____ which is:
- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/DE 03/02214

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-9	YES
	Claims		NO
Inventive step (IS)	Claims		YES
	Claims	1-9	NO
Industrial applicability (IA)	Claims	1-9	YES
	Claims		NO

2. Citations and explanations

This report makes reference to the following documents:

D1: DE 100 54 379 A1

D2: WO 02/23933 A1.

A. Citations and explanations:

- As the applicant himself indicated on page 1, lines 18 to 32 of the present description, a method for switching from a first mobile communication device to a second mobile communication device according to the features of the preamble of **claim 1** is generally known.

In this context, reference is also made to D1 (see, in particular, column 1, lines 39 to 46), in which the principle of "twin cards" and the corresponding switching between communication devices is briefly outlined.

Upon closer examination of the known method for switching, however, it becomes clear to a person skilled in the art that a considerable **disadvantage** of this method is that the switching requires

considerable effort, since the subscriber has to ensure that the communication device with which he presently wants to communicate was the last to check in to the network, since the calls accumulate at the last communication device to log in.

A person skilled in the art who, in seeking a solution to overcome the above-mentioned disadvantage, consulted the prior art in the field of mobile radio telephone systems and corresponding switching methods involving the use of two SIM cards by the same subscriber, would happen upon D2, which offers the principle behind a corresponding **solution**. Specifically, D2 discloses (see, in particular, the abstract; page 3, line 26 to page 5, line 16; page 8, line 18 to page 9, line 7; page 10, line 16 to page 13, line 5; figure 1) a method for switching from a first mobile communication device (see page 12, lines 8 to 15; "118" in figure 1) to a second mobile communication device (see page 10, line 16 to page 11, line 9, "101" in figure 1), the switching being carried out automatically (see in particular page 12, line 16 to page 13, line 5) by means of signals transmitted between the first and the second communication devices via a wireless interface (see "111" and "113" in figure 1).

Proceeding from the method for switching generally known from D1, for example, and with knowledge of the disclosure of D2, it would be obvious for a person skilled in the art to apply **the principle** behind the solution described in D2 to the generally known method in order to overcome the disadvantage mentioned above, and therefore to arrive at a method for switching from a first mobile communication

device to a second mobile communication device according to the features of claim 1, **without** thereby being inventive.

Therefore, the subject matter of claim 1 contains only a combination of known and obvious measures, each of which is used in its conventional manner. This combination does not result in any inventive interaction that goes beyond the expected combined effect of said measures in the form of mutual and effective support that results in a new technical achievement.

Consequently, the subject matter of the present claim 1 **cannot** be regarded as involving an inventive step (PCT Article 33(3)).

2. The same observations as those in point 1 with respect to claim 1 also apply to **independent claim 6**, since claim 6 is based on the same combination of features as in claim 1, in the form of a claim related to an arrangement (i.e. mobile radio telephone system).

Therefore, the subject matter of claim 6 **cannot** be regarded as involving an inventive step (PCT Article 33(3)).

3. **Dependent claims 2 to 5 and 7 to 9** also contain no additional features which, in combination with the features of any claim to which any one of them refers, could lead to subject matter involving an inventive step, since the features of these claims are merely developments of the method of claim 1 and the mobile radio telephone system of claim 6 that **either** likewise can be derived from D1 (for claims

2, 3 and 7: see, in particular, page 11, lines 10 to 15; for claims 4 and 8; see, in particular, page 9, lines 1 to 2 and page 12, line 25 to page 13, line 2) or are design details that are already **generally known** to a person skilled in the art of mobile radio telephony (claims 5 and 9; it is noted that authenticating a subscriber by requesting his PIN is a standard measure in second generation mobile radio telephone systems).

Therefore, dependent claims 2 to 5 and 7 to 9 do not meet the requirements of PCT Article 33(3).

B. Additional observations with respect to the present application:

1. Claims 6, 8 and 9 do not meet the requirements of PCT Article 6 with respect to the requisite clarity, since, as device claims (i.e. a mobile radio telephone system) they essentially contain method features; that is, the features of claims 6, 8 and 9 refer to the functionality of the mobile radio telephone system rather than prescribing clear restrictions for the mobile radio telephone system in the form of device features.

It is pointed out that features that refer to actions carried out by a device (i.e. "doing something with the help of means"), as in the present case, are regarded as method features. In contrast, features that describe a device (for example "means for...") are regarded as device features (see also PCT Guidelines, paragraph III-3.1 and 4.1).

Therefore, amendments should have been made

accordingly to the above-mentioned claims (pursuant to PCT Article 34(2)(b)).

2. In order to meet the requirements of PCT Rule 6.3(b), each independent claim should have been clearly delimited over the closest prior art in the **two-part form**.
3. In order to meet the requirements of PCT Article 5.1(a)(ii), the introductory part of the description should have cited D1 and D2, which disclose prior art relevant to the present application, and the prior art contained therein should have been outlined in brief.